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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,912	02/06/2004	Constantine A. Domashnev	4461-040040	7385

28289 7590 02/05/2008
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EXAMINER

SEREBOFF, NEAL

ART UNIT	PAPER NUMBER
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3626

MAIL DATE	DELIVERY MODE
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02/05/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/773,912	Applicant(s) DOMASHNEV, CONSTANTINE A.	
	Examiner Neal R. Sereboff	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment/ Notice to Applicant

1. In the amendment filed 5/16/2007, the following has occurred. Claims 1 and 13 have been amended. Claims 1 through 22 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. ***Claims 1, 12, 13*** are rejected under 35 U.S.C 103(a) as being unpatentable over Munoz et al, U.S. Pre-Grant Publication Number 2002/ 0052760 in view of Henley, U.S. Pre-Grant Publication 2003/ 0195838.

4. As per claim 1, Munoz teaches an electronic prescription handling system comprising:

(a) A first computer configured to transmit a prescription by a physician (figure 14 for network design and paragraph 58 for the prescribing physician);

(b) A server communicatively connected to the first computer and functionally distinct therefrom (figure 14, server 332 and pc 306 or third party system 320), wherein the server is configured to receive the prescription from the first computer, wherein the server is remote from the first computer (figure 14 where the server is connected through the Internet as discussed in paragraph 58) and is operated by a service provider (figure 14 #318 and paragraph 72 to show the computer is operated by the service provider);

(c) A first pharmacy having a first pharmacy computer communicatively connected to the server, wherein the first pharmacy computer is configured to:

- Retrieve the prescription from the server (figure 14 where the third party may be any number of third parties as described in paragraph 72); and
- Transmit a first bid for the prescription to the server (paragraph 67), wherein the first bid is stored on the server (67 where the bid results are compiled or stored);

(d) A second pharmacy having a second pharmacy computer communicatively connected to the server, wherein the second pharmacy computer is configured to:

- Retrieve the prescription from the server (figure 14 where the third party may be any number of third parties as described in paragraph 72); and
- Transmit a second bid for the prescription to the server (paragraph 67), wherein the second bid is stored on the server (67 where the bid results are compiled or stored); and

(e) A second computer communicatively connected to the server (figure 14).

Munoz does not explicitly teach the system wherein

(e) A second computer communicatively connected to the server, wherein the second computer is operated by a patient and is configured to:

- Retrieve the first bid and the second bid; and
- Select one of (i) the first bid, and (ii) the second bid;
- Such that
 - When the first bid is selected, the first pharmacy fills the prescription; and

- When the second bid is selected, the second pharmacy fills the prescription.

However, Henley teaches the system wherein

(e) A second computer communicatively connected to the server, wherein the second computer is operated by a patient and is configured to (figure 8 and paragraphs 63 and 83 where the buyer is a patient):

- Retrieve the first bid and the second bid; and
- Select one of (i) the first bid, and (ii) the second bid (paragraph 101 where the bids are for the medical service that according to paragraph 93 could also be for prescriptions);
- Such that
 - When the first bid is selected, the first pharmacy fills the prescription (paragraph 102 where the parties of the transaction are the winning bidders); and
 - When the second bid is selected, the second pharmacy fills the prescription (paragraph 102 where the parties of the transaction are the winning bidders).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these features into Munoz. One of ordinary skill in the art would have incorporated these features into Munoz with the motivation to enable prospective clients/ patients and professional service providers to competitively negotiate fees for proffered services through an

interactive on-line professional services auction transaction system implemented over a publicly accessible communications network such as the Internet (Henley abstract).

5. As per claim 12, Munoz in view of Henley teaches the system of claim 1 as described above. Munoz further teaches the system wherein the first pharmacy is one of a brick-and-mortar pharmacy and an online pharmacy (paragraph 67 where the local pharmacies are brick-and-mortar and a US pharmacy may be either brick-and-mortar and online or both brick-and-mortar and online and further where the pharmacy type is non-functional).

6. As per claim 13, Munoz teaches a method for issuing a prescription comprising the steps of:

- Transmitting a prescription from a first computer by a physician (figure 14 for network design and paragraph 58 for the prescribing physician);
- Receiving the prescription on a server functionally distinct from the first computer (figure 14, server 332 and pc 306 or third party system 320), wherein the server is remote from the first computer (figure 14 where the server is connected through the Internet as discussed in paragraph 58) and is operated by a service provider (figure 14 #318 and paragraph 72 to show the computer is operated by the service provider);
- Retrieving the prescription from the server (figure 14 where the third party may be any number of third parties as described in paragraph 72);
- Submitting a first bid for the prescription to the server from a first pharmacy having a first pharmacy computer (67 where the bid results are compiled or stored);
- Submitting a second bid for the prescription to the server from a second pharmacy having a second pharmacy computer (67 where the bid results are compiled or stored);

- Storing the first bid and the second bid on the server (paragraph 100 where the global database is on the server);
- Transmitting the first bid and the second bid to a second computer (67 where the bid results are compiled or stored);
- Viewing the first bid and the second bid on the second computer (paragraph 67).

Munoz does not explicitly teach the method comprising

- Transmitting the first bid and the second bid to a second computer operated by a patient;
- Making a selection consisting of one of (i) the first bid, and (ii) the second bid;
- Transmitting the selection to the server; and
- Informing one of (i) the first pharmacy, and (ii) the second pharmacy to fill the prescription.

Munoz does not explicitly teach the method comprising

- Transmitting the first bid and the second bid to a second computer operated by a patient (figure 8 and paragraphs 63 and 83 where the buyer is a patient);
- Making a selection consisting of one of (i) the first bid, and (ii) the second bid (paragraph 101 where the bids are for the medical service that according to paragraph 93 could also be for prescriptions);
- Transmitting the selection to the server (paragraph 102 where the server makes the selection and the pharmacies notice the selection); and
- Informing one of (i) the first pharmacy, and (ii) the second pharmacy to fill the prescription (paragraph 102 where the parties of the transaction are the winning bidders).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these features into Munoz. One of ordinary skill in the art would have incorporated these features into Munoz with the motivation to enable prospective clients/ patients and professional service providers to competitively negotiate fees for proffered services through an interactive on-line professional services auction transaction system implemented over a publicly accessible communications network such as the Internet (Henley abstract).

7. As per claim 16, Munoz in view of Henley teaches the method of claim 13 as described above. Munoz in view of Henley further teaches the method comprising the steps of transmitting to the second computer at least one of:

- Contact information of one of (i) the first pharmacy, and (ii) the second pharmacy (paragraph 67);
- A set of directions from one of (i) the first pharmacy, and (ii) the second pharmacy to an address specified by the second computer; and
- A map-illustrating an address on the map of one of (i) the first pharmacy, and (ii) the second pharmacy.

8. ***Claims 2 – 9 and 14 – 15*** are rejected under 35 U.S.C 103(a) as being unpatentable over Munoz et al, U.S. Pre-Grant Publication Number 2002/ 0052760 in view of Henley, U.S. Pre-Grant Publication 2003/ 0195838 as applied to claims 1 and 13 as above and further in view of Hwangbo, U.S. Pre-Grant Publication Number 2003/ 0154376.

9. As per claim 2, Munoz in view of Henley teaches the system of claim 1 as described above.

Munoz in view of Henley does not explicitly teach the electronic prescription handling system further comprising a portable storage medium configured to be interfaced with the first computer, wherein the portable storage medium includes an application for transmitting a digital certificate to the server when the portable storage medium interfaces with the first computer.

However, Hwangbo teaches the electronic prescription handling system further comprising

- A portable storage medium configured to be interfaced with the first computer (paragraph 1),
 - Wherein the portable storage medium includes an application (paragraph 1)
 - For transmitting a digital certificate (paragraph 1)
 - To the server (figure 13)
 - When the portable storage medium interfaces with the first computer (paragraph 67 where the certificates automatically access the server).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these features into Munoz in view of Henley. One of ordinary skill in the art would have incorporated these features into Munoz in view of Henley with the motivation to provide certification and security in electronic commerce (Hwangbo paragraph 1).

10. As per claim 3, Munoz in view of Henley, further in view of Hwangbo teaches the system of claim 2 as described above.

Munoz in view of Henley does not explicitly teach the electronic prescription handling system wherein the portable storage medium is one of (i) a CD-ROM, (ii) a DVD-ROM, and (iii) flash memory.

However, Hwangbo teaches the electronic prescription handling system wherein the portable storage medium is one of (i) a CD-ROM, (ii) a DVD-ROM, and (iii) flash memory (paragraph 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these features into Munoz in view of Henley. One of ordinary skill in the art would have incorporated these features into Munoz in view of Henley with the motivation to provide certification and security in electronic commerce (Hwangbo paragraph 1).

11. As per claim 4, Munoz in view of Henley, further in view of Hwangbo teaches the system of claim 2 as described above.

Munoz in view of Henley does not explicitly teach the electronic prescription handling system wherein the server is configured to authenticate the digital certificate.

However, Hwangbo teaches the electronic prescription handling system wherein the server is configured to authenticate the digital certificate (figure 13).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these features into Munoz in view of Henley. One of ordinary skill in the art would have incorporated these features into Munoz in view of Henley with the motivation to provide certification and security in electronic commerce (Hwangbo paragraph 1).

12. As per claim 5, Munoz in view of Henley, further in view of Hwangbo teaches the system of claim 4 as described above.

Munoz further teaches the electronic prescription handling system wherein the server is configured to transmit a prescription entry web page to the first computer upon the server authenticating (paragraph 63 where the physician logs in).

Munoz does not explicitly teach the electronic prescription handling system wherein the server is configured to transmit a prescription entry web page to the first computer upon the server authenticating the digital certificate.

However, Hwangbo teaches the electronic prescription handling system wherein the server is configured to transmit a prescription entry web page to the first computer upon the server authenticating the digital certificate (paragraph 87 where the mail is a web entry page as described in paragraph 33 where the medium is pre-inserted).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these features into Munoz in view of Henley. One of ordinary skill in the art would have incorporated these features into Munoz in view of Henley with the motivation to provide certification and security in electronic commerce (Hwangbo paragraph 1).

13. As per claim 6, Munoz in view of Henley, further in view of Hwangbo teaches the system of claim 5 as described above.

Munoz further teaches the system wherein

- A pharmaceutical database for storing a plurality of drug formularies therein (paragraph 64).

Munoz does not explicitly teach the system wherein

- A physician database utilized to authenticate the digital certificate.

However, Hwanbo teaches the system wherein

- A physician database utilized to authenticate the digital certificate (paragraph 115 where the user is a physician).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these features into Munoz in view of Henley. One of ordinary skill in the art would have incorporated these features into Munoz in view of Henley with the motivation to provide certification and security in electronic commerce (Hwangbo paragraph 1).

14. As per claim 7, Munoz in view of Henley, further in view of Hwangbo teaches the system of claim 6 as described above.

Munoz further teaches the system wherein the server comprises:

- A prescription database for storing the prescription received from the first computer (figure 14 where database 304 or database 334 stores the information);
- A patient database for storing patient information (figure 14 where database 304 or database 334 stores the information);
- A pharmacy database for storing pharmacy data (figure 14 where database 304 or database 334 stores the information); and
- A bid database for storing the first bid and the second bid (figure 14 where database 304 or database 334 stores the information).

15. As per claim 8, Munoz in view of Henley, further in view of Hwangbo teaches the system of claim 7 as described above.

Munoz further teaches the system wherein the patient information comprises at least one of (i) an insurance provider identifier for the patient, (ii) a medical history for the patient, (iii) a drug

interaction list for the patient, and (iv) an allergic reaction list for the patient (figure 13 where the insurance company and patient history is entered).

16. As per claim 9, Munoz in view of Henley, further in view of Hwangbo teaches the system of claim 7 as described above.

Munoz further teaches the system wherein the pharmacy data comprises contact information for one of (i) the first pharmacy and, (ii) the second pharmacy (paragraph 67).

17. As per claim 14, Munoz in view of Henley teaches the method of claim 13 as described above.

Munoz in view of Henley does not explicitly teach the steps of:

- Interfacing a portable storage medium with the first computer, wherein the portable storage medium includes an application for transmitting a digital certificate; and
- Transmitting the digital certificate to the server.

Chan teaches the steps of:

- Interfacing a portable storage medium with the first computer (paragraph 1), wherein the portable storage medium includes an application (paragraph 1) for transmitting a digital certificate (paragraph 1); and
- Transmitting the digital certificate to the server (figure 13).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these features into Munoz in view of Henley. One of ordinary skill in the art would have incorporated these features into Munoz in view of Henley with the motivation to provide certification and security in electronic commerce (Hwangbo paragraph 1).

18. As per claim 15, Munoz in view of Henley, further in view of Hwangbo teaches the method of claim 14 as described above.

Munoz further teaches the step of transmitting a prescription entry web page to the first computer (paragraph 63 where the physician logs in).

Munoz does not explicitly teach the step of authenticating the digital certificate on the server.

However, Hwangbo teaches the step of authenticating the digital certificate on the server (paragraph 87 where the mail is a web entry page as described in paragraph 33 where the medium is pre-inserted).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these features into Munoz in view of Henley. One of ordinary skill in the art would have incorporated these features into Munoz in view of Henley with the motivation to provide certification and security in electronic commerce (Hwangbo paragraph 1).

19. ***Claims 10 and 11*** are rejected under 35 U.S.C 103(a) as being unpatentable over Munoz et al, U.S. Pre-Grant Publication Number 2002/ 0052760 in view of Henley, U.S. Pre-Grant Publication 2003/ 0195838 as applied to claim 1 above and further in view of Hwangbo, U.S. Pre-Grant Publication Number 2003/ 0154376 as applied to claims 2 through 9 above, and further in view of McCormick, U.S. Pre-Grant Publication Number 2002/0035484.

20. As per claim 10, Munoz in view of Henley, further in view of Hwangbo teaches the system of claim 9 as described above.

Munoz in view of Henley, further in view of Hwangbo do not explicitly teach the system wherein the server is further configured to transmit at least one of (i) an address of the first

pharmacy or second pharmacy, and (ii) a set of directions from the first pharmacy or second pharmacy to an address specified by the second computer.

However, McCormick teaches the electronic prescription handling system wherein the server is further configured to transmit at least one of (i) an address of the first pharmacy or second pharmacy, and (ii) a set of directions from the first pharmacy or second pharmacy to an address specified by the second computer (paragraph 89).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into Munoz in view of Henley, further in view of Hwangbo. One of ordinary skill in the art would have incorporated this feature Munoz in view of Henley, further in view of Hwangbo with the motivation to eliminate inefficiencies at the doctor's office in generating the prescription (McCormick paragraph 5).

21. As per claim 11, Munoz in view of Henley, further in view of Hwangbo teaches the system of claim 10 as described above.

Munoz in view of Henley, further in view of Hwangbo does not explicitly teach the electronic prescription handling system wherein the server is further configured to transmit a map illustrating the address on the map of one of (i) the first pharmacy, and (ii) the second pharmacy.

However, McCormick teaches the electronic prescription handling system wherein the server is further configured to transmit a map illustrating the address on the map of one of (i) the first pharmacy, and (ii) the second pharmacy (paragraph 90).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into Munoz in view of Henley, further in view of Hwangbo. One of ordinary skill in the art would have incorporated this feature Munoz in view of Henley, further in

view of Hwangbo with the motivation to eliminate inefficiencies at the doctor's office in generating the prescription (McCormick paragraph 5).

22. **Claims 17 – 22** are rejected under 35 U.S.C 103(a) as being unpatentable over Henley, U.S. Pre-Grant Publication Number 2002/0065758 in view of Chan et al., U.S. Pre-Grant Publication Number 2001/0039503 and Felsher, U.S. Pre-Grant Publication Number 2002/0010679.

23. As per claim 17, Henley teaches an electronic prescription handling system comprising:

- A computer (paragraph 32);
- A server communicatively connected to the computer (paragraph 32);
- Further wherein a user of the computer enters a prescription (paragraph 93 where a medical service is defined as a pharmacy) into the prescription entry web page (and paragraph 94 where the prescription service is entered), and thereafter the computer transmits the prescription to the server (paragraph 94).

Henley does not explicitly teach an electronic prescription handling system comprising:

- A portable storage medium configured to interface with the computer;
- An application residing on the portable storage medium, wherein the application is configured to execute once the portable storage medium interfaces with the computer, further wherein the application is configured to transmit a digital certificate to the server upon the application sensing a network connection to the server; and
- Means for authenticating the digital certificate on the server, wherein when the digital certificate is positively authenticated, the server transmits a prescription entry web page to the computer.

However, Chan teaches an electronic prescription handling system comprising:

- A portable storage medium configured to interface with the computer (paragraph 83 where the portable medium is a CD-ROM);
- An application residing on the portable storage medium (paragraph 83 where the software is stored on the CD-ROM), and
- Means for authenticating the digital certificate on the server (paragraph 73), wherein when the digital certificate is positively authenticated (paragraph 73), the server transmits a prescription entry web page to the computer (paragraph 65 where the GUI is a web page and the level is restricted to the physician).

And Felsher teaches an electronic prescription handling system comprising:

- An application residing on the portable storage medium wherein the application is configured to execute once the portable storage medium interfaces with the computer, further wherein the application is configured to transmit a digital certificate (paragraph 245 where the key is stored on the portable medium).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate these features into Henley. One of ordinary skill in the art would have motivated to incorporate these features into Henley to facilitate access to and utilization of the associated data stores and resources by the major participants in the health and wellness program (Chan paragraph 9) and to provide a comprehensive set of technologies to address the full scope of issues presented in implementing a secure and versatile medical information infrastructure that respects the rights of patients (Felsher paragraph 190).

24. As per claim 18, Henley in view of Chan and Felsher teach the system of claim 17 as described above.

Henley does not explicitly teach the electronic prescription handling system wherein the portable storage medium is one of (i) a CD-ROM, (ii) a DVD-ROM, and (iii) flash memory.

However, Chan teaches the electronic prescription handling system wherein the portable storage medium is one of (i) a CD-ROM, (ii) a DVD-ROM, and (iii) flash memory (paragraph 83 where the portable storage medium is a CD-ROM).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into Henley in view of Chan and Felsher. One of ordinary skill in the art would have motivated to incorporate this feature into Henley in view of Chan and Felsher to facilitate access to and utilization of the associated data stores and resources by the major participants in the health and wellness program (Chan paragraph 9).

25. As per claim 19, Henley in view of Chan and Felsher teach the system of claim 17 as described above.

Henley does not explicitly teach the electronic prescription handling system wherein the digital certificate identifies a physician.

However, Chan teaches the electronic prescription handling system wherein the digital certificate identifies a physician (paragraph 73 where the user is a physician).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into Henley in view of Chan and Felsher. One of ordinary skill in the art would have motivated to incorporate this feature into Henley in view of Chan and

Felsher to facilitate access to and utilization of the associated data stores and resources by the major participants in the health and wellness program (Chan paragraph 9).

26. As per claim 20, Henley in view of Chan and Felsher teach the system of claim 18 as described above.

Henley does not explicitly teach the electronic prescription handling system wherein the digital certificate is hidden on the portable storage medium.

However, Felsher teaches the electronic prescription handling system wherein the digital certificate is hidden on the portable storage medium (paragraph 247 where the certificate is the hidden message).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into Henley in view of Chan and Felsher. One of ordinary skill in the art would have motivated to incorporate this feature into Henley in view of Chan and Felsher to provide a comprehensive set of technologies to address the full scope of issues presented in implementing a secure and versatile medical information infrastructure that respects the rights of patients (Felsher paragraph 190).

27. As per claim 21, Henley in view of Chan and Felsher teaches the system of claim 20 as described above.

Henley does not explicitly teach the electronic prescription handling system wherein the digital certificate cannot be copied from the portable storage medium.

However, Felsher teaches the electronic prescription handling system wherein the digital certificate cannot be copied from the portable storage medium (paragraph 247).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into Henley in view of Chan and Felsher. One of ordinary skill in the art would have motivated to incorporate this feature into Henley in view of Chan and Felsher to provide a comprehensive set of technologies to address the full scope of issues presented in implementing a secure and versatile medical information infrastructure that respects the rights of patients (Felsher paragraph 190).

28. As per claim 22, Henley in view of Chan and Felsher teaches the system of claim 19 as described above. Henley further teaches the electronic prescription handling system wherein the server transmits the prescription to a pharmacy (paragraph 93 where plurality includes a first pharmacy computer).

Response to Arguments

29. Applicant's arguments filed 10/25/2007 have been fully considered but they are not persuasive.

- Regarding Independent Claims 1 and 13
 - Applicant's argues that Munoz does not disclose a system in the context of a service provider. The Applicant does not define a service provider to be anything more than someone or something that operates a server (Detailed Description paragraph 25).
 - In comparing the drawings, the Applicant is reminded that combining servers or separating into separate servers is not patentable but a matter of design choice. (MPEP 2144)

- “There is no service provider to serve as an intermediary for receiving bids.” If claimed, this statement represents the intended use of the claimed server. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.
- In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a reverse auction) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
 - If the Applicant further amends the claims to include "a reverse auction," the Applicant is reminded to additionally show support for this limitation. Also, the Examiner notes that Henley describes other auction types within paragraphs 63 and 83.
- In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

- Regarding Independent Claims 17
 - The Applicant states that the claim requires “the auto-execution aspect.” The Examiner again asserts that this feature is not claimed. The relevant portion of claim 17 reads:
 - “An application residing on the portable storage medium wherein the application is configured to execute once the portable storage medium interfaces with the computer, further wherein the application is configured to transmit a digital certificate.”
 - The Applicant writes, “Just because the Examiner deems that additional steps take place in the auto-execution of the application on the medium, this has no bearing on the fact that the Examiner has not met this burden of proof in providing prior art references disclosing the limitations of claim 17.” The Examiner again states that the auto-execute functionality is not claimed.
 - The detailed description states, “It is to be understood that the first computer 14 may be configured to automatically execute the application residing on the CD-ROM via automatic execution protocols inherent in the operating system of the first computer 14. An example of such an automatic execution protocol is the "auto-run" feature found in the Windows® operating system. Upon execution of the application, the digital certificate is transmitted to the server 12.” As stated, the computer “may be configured” but is not required to be configured.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neal R. Sereboff whose telephone number is (571) 270-1373. The examiner can normally be reached on Mon thru Thur from 7:30am to 5pm, with 1st Fri off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/NRS/
12/17/2007

/C. Luke Gilligan/
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